

REMARKS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

This Amendment is filed in conjunction with a Request for Continuing Examination, or RCE, in response to the Final Office Action mailed on May 17, 2004. Claims 1-7 are pending in the Application and stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kikukaya et al. (U.S. Patent No. 6,169,722, hereinafter "Kikukaya").

Applicants have filed concurrently with this amendment a declaration under 37 C.F.R. § 1.131, containing the following statements:

- (a) The invention claimed in Kikukaya, i.e., a recording layer with Ag, In, Sb, and Te, was invented by Mr. Takashi Kikukawa and Mr. Hajime Utsunomiya;
- (b) The invention described in the comparative examples of Kikukaya, i.e., a recording layer with Ge, Sb, Te, and without Ag, was invented by Mr. Hiroshi Shingai, Mr. Hiroyasu Inoue, Mr. Tatsuya Kato, Mr. Hajime Utsunomiya, and Mr. Takashi Kikukawa;
- (c) The invention recited in the pending claims of this application before the Amendment filed on February 26, 2004, i.e., a recording layer with Sb as a main component, was invented by Mr. Hiroshi Shingai, Mr. Hiroyasu Inoue, Mr. Tatsuya Kato, Mr. Hajime Utsunomiya, and Mr. Takashi Kikukawa;
- (d) The invention recited in the pending claims of this application after the amendment filed on February 26, 2004, i.e., a recording layer with Sb as a main component, but without Ag, was invented by Mr. Hiroshi Shingai, Mr. Hiroyasu Inoue, Mr. Tatsuya Kato, Mr. Hajime Utsunomiya, and Mr. Takashi Kikukawa; and
- (e) The subject matter of the comparative examples described in col. 3, lines 29-48 and col. 13, lines 6-13 of Kikukaya was made first, compared to the invention claimed in Kikukaya, was thereafter described in Kikukaya, and was later filed in this application.

Applicants respectfully submit that based on the provisions of MPEP § 2136.05 and the concurrently filed declaration under 37 C.F.R. § 1.131, the invention claimed in this

application was not made by another when compared to Kikukaya, thus Kikukaya cannot be a reference cited in support of an anticipation rejection under 35 U.S.C. § 102(e).¹

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-7 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representatives at the below listed telephone number.

Respectfully submitted,

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¹ "The fact that an application has named a different inventive entity than a patent does not necessarily make that patent prior art." *Applied Materials Inc. v. Gemini Research Corp.*, 835 F.2d 279, 15 USPQ2d 1816 (Fed. Cir. 1988). The issue turns on what the evidence of record shows as to who invented the subject matter. *In re Whittle*, 454 F.2d 1193, 1195, 172 USPQ 535, 537 (CCPA 1972). In fact, even if applicant's work was publicly disclosed prior to his or her application, applicant's own work may not be used against him or her unless there is a time bar under 35 U.S.C. 102(b). *In re DeBaun*, 687 F.2d 459, 214 USPQ 933 (CCPA 1982) (citing *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982)). Therefore, when the unclaimed subject matter of a reference is applicant's own invention, applicant may overcome a *prima facie* case based on the patent, U.S. patent application publication, or international application publication, by showing that the disclosure is a description of applicant's own previous work. Such a showing can be made by proving that the patentee, or the inventor(s) of the U.S. patent application publication or the international application publication, was associated with applicant (e.g. worked for the same company) and learned of applicant's invention from applicant. *In re Mathews*, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969). ***In the situation where one application is first filed by inventor X and then a later application is filed by X & Y, it must be proven that the joint invention was made first, was thereafter described in the sole applicant's patent, or was thereafter described in the sole applicant's U.S. patent application publication or international application publication, and then the joint application was filed.*** *In re Land*, 368 F.2d 866, 151 USPQ 621 (CCPA 1966). MPEP § 2136.05 (emphasis in bold added).